

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Joseph BACH	Group Art Unit: 3629
APPLN. NO. 09/327,085	Examiner: VIG, Naresh
FILED: June 4, 1999	February 17, 2003
ENTITLED: SYSTEM AND METHOD FOR SOLICITING AND RECEIVING MERCHANDISE ORDERS	Morgan Hill, California

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GROUP 3600

APPEAL BRIEF

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Board of Patent Appeals and Interferences:

This is an Appeal Brief in response to the Examiner's Final Rejection and Appellant's Notice of Appeal filed on October 28, 2002.

The fees required under § 1.17(f), and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF. Appellant hereby petitions for any extension of time that may be required to keep this Application pending.

This brief is transmitted in triplicate.

(1) Real Party in Interest

The real party in interest of the present application is the Appellant, Joseph Bach.

(2) Related Appeals and Interferences

None.

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01 FC:2402
02 FC:2251

160.00 OP
55.00 OP

(3) Status of Claims

Claims 1, 2, 5 and 6 are presently pending in this Application. Claims 1, 2, 5 and 6 are finally rejected by the Examiner. Claims 10 and 12 were previously canceled by an Amendment After Final.

(4) Status of Amendments

A Response to Final Office Action was filed on September 24, 2002, canceling claims 10 and 12, but making no amendments to the claims 1, 2, 5 and 6. In an Advisory Action dated 1/16/2003, the Examiner indicated that for the purpose of Appeal, the Amendment will be entered.

(5) Summary of the Invention

The present invention relates to a system enabling the placing of orders for merchandise (¶

0001, note: references made herein relate to the substitute specification filed on May 13, 2002, and never objected to by the Examiner in any subsequent communications). The system is generally a home audio receiver that receives and plays audio programs (§ 0006). The audio receiver further includes a rider buffer that receives and stores a rider signal from the transmitted audio program (§ 0006). That is, for an implementation of the invention, the transmission of audio program also includes a transmission of a rider signal which includes various information relating to the audio program (§ 0006). For example, when the audio program is a song, the rider signal may include the song, artist, and album names (§ 0006). The audio player may also include an ordering memory, for storing information relating to the user, such as mailing address, billing address, etc. (§ 0006).

When the user hears a song he/she would like to order, the user may press the “order” button on the user interface (§ 0007). When the audio player receives the “order” signal, it establishes a line of communication to an ordering center via the phone system (§ 0007). When the line of communication is established, the audio system fetches the information from the rider buffer and, optionally, from the order memory, and places an order for the song that was playing when the “order” button was pressed (§ 0007).

An illustrative system is depicted in Figure 1, and is reproduced here for convenience. A programming signal and a corresponding rider signal are received via the I/O interface 100 (§ 0015). The main program 200 sends the program signal to the audio player 300, and the rider signal to the rider buffer 400 (§ 0015). When a user hears a particular song the user may wish to purchase, the user may place an order using the user interface 500 (§ 0017). If that happens, ordering interrupt 600 establishes communication line with the ordering center and places an order corresponding to the information in the rider buffer 400 (§ 0017).

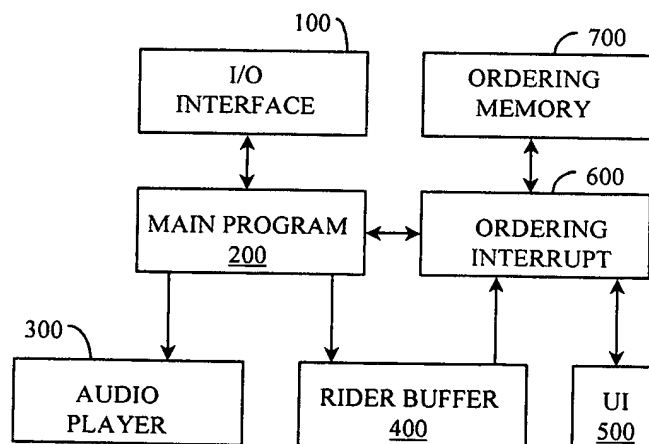


FIGURE 1

(6) Issues

There is presently one issue presented to the Board of Appeals for review:

- (i) Whether claims 1, 2, 5 and 6 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,389,055 to August (hereinafter August), in view of U.S. Patent 5,303,393 to Noreen (hereinafter Noreen).

(7) Grouping of claims

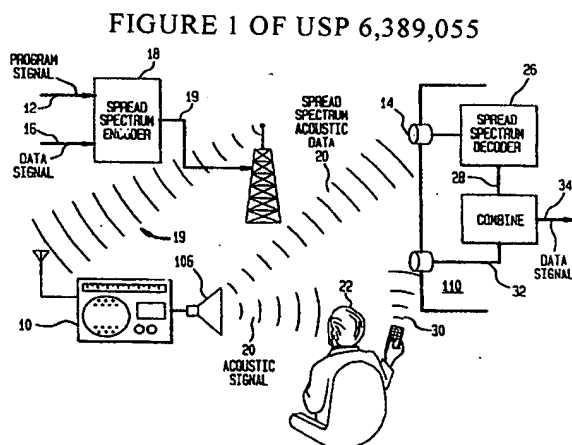
Each of claims 2, 5, and 6 stands or falls together with independent claim 1.

(8) Argument

Each of claims 1, 2, 5 and 6 are improperly rejected and are allowable for at least the reasons set forth below. Appellant respectfully requests reversal of all grounds of rejection set forth by the Examiner. Preliminary, Applicant notes that while the Examiner quoted 35 USC § 103(a), the Examiner stated that the claims “are rejected under 35 USC § 102 as being unpatentable over August et al. US Patent 6,389,055 in view of Noreen et al. US Patent 5,303,393.” Consequently, it is unclear under which Section the claims are rejected. Since the Examiner quoted Section 103, and since the Examiner used the term “unpatentable,” which is generally the standard of Section 103, and since the Examiner combined two references to make the rejection – a practice available only under Section 103, Applicant assumes that the rejection was meant to be under Section 103(a).

(A) 35 USC 103(a) rejection of claim 1

For the most part, the Examiner relies on August in making the rejection. Appellant respectfully submits that August, independently or in combination with Noreen or any other prior art of record, fails to disclose, suggest, or make obvious the claimed invention. For the Board’s convenience, Figure 1 of August is reproduced herein-below.



With reference to column 2, line 66, to column 3, line 43, of August, a program signal 12 and a data (rider) signal 16 are combined by the spread spectrum encoder 18 and are transmitted as a combined broadcast signal 19. A conventional monitor 10, such as a radio or TV, receives the combined signal and plays the combined signal. That is, the data signal is encoded into the program signal "such that the effect on audio signal 20 is imperceptible, or at least unobjectionable" (cl. 3, ln. 12-14). A separate capture device 110 utilizes a microphone 14 to receive the combined signal as reproduced by the loudspeaker 106. The output of microphone 14 is sent to a spread spectrum decoder 26, which "is only sensitive to the digital data encoded onto the audio signal by the spread spectrum encoder 18" (cl. 3, ln. 39-41). The captured data may be stored "for future use or to initiate a transaction with a seller of goods" (cl. 3, ln. 26-28).

As can be understood from August's disclosure and from the above reproduced Figure 1, August teaches the use of a conventional (unmodified) audio/video device (monitors 10 and 105) to reproduce the incoming program and data signals as combined audio signal 20. That is, contrary to the claimed invention, August teaches not to separate the rider signal from the program signal prior to providing the audio signal. Rather, August teaches to maintain them together and send both of them to the audio player, relying on the encoding to provide a combined signal that is imperceptible or unobjectionable to the listener. August provides a separate device, spread spectrum decoder 26, to receive only the rider signal and store it for future transactions. The Examiner failed to provide any indication or reasoning of how any other prior art may be utilized to remedy this deficiency - in effect, teaching to the contrary - of August.

More specific to the claim language, Appellant respectfully submits that August fails to disclose or suggest the limitation:

"a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer;"

That is, according to the claimed invention, a main processor of the audio system receives a signal that includes both the programming signal and the rider signal. This main processor then sends the program signal to the audio player and stores the remaining raider signal in a rider buffer of the audio system. Such an apparatus is not disclosed nor suggested by the combined prior art.

In August, for example, a receiver, such as a radio or a television, receives the program signal and the rider signal and plays both signals. The receiver does not separate the signals, does not store the rider signal in a rider buffer - nor is there a suggestion or a motivation to do so as August discloses a capture

device 110 for that purpose. Therefore, August clearly fails to disclose or suggest the limitation "directing said programming signal to the audio player and storing the rider signal in the rider buffer;" as August discloses directing both the program signal and the rider signal to the audio player and fails to disclose storing the rider in a rider buffer.

On the other hand, August discloses a "capture device" that captures the rider signal. However, even if one considers the capture device to correspond to the claimed "main processor," it still fails to disclose or suggest the quoted limitation. That is, August's capture device fails to disclose or suggest the limitation "directing said programming signal to the audio player," because in August the programming signal has already been played and perceived by the user. Again, the Examiner failed to provide any indication as to how August combined with Noreen make this limitation obvious.

Thus, as can be seen, the claimed limitation to "main processor" is not disclosed nor suggested by August. If one argues that August's receiver 10 is the main processor, then August's "main processor" fails to store the rider signal on a rider buffer, but rather plays the rider signal on the audio player. If one argues that August's capture device 110 is the main processor, then August's "main processor" fails to send the programming signal to the audio player. Even if one takes the entire system of August to be the claimed Audio system, still there's no disclosure or suggestion for an element that corresponds to the claimed "main processor." That is, there's no teaching or suggestion for an element that receives the combined signal, sends the program signal to the audio player, and sends the rider signal to a memory.

Conclusion

It is believed that all rejections made by the Examiner have been addressed and overcome by the above arguments. Therefore, it is respectfully submitted that all of the pending claims are allowable. Accordingly, a reversal of all the pending rejections is respectfully requested.

Respectfully submitted,

Dated: February 17, 2003

Joseph Bach; Reg. No. 37,771

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device 110 for that purpose. Therefore, August clearly fails to disclose or suggest the limitation “directing said programming signal to the audio player and storing the rider signal in the rider buffer,” as August discloses directing both the program signal and the rider signal to the audio player and fails to disclose storing the rider in a rider buffer.

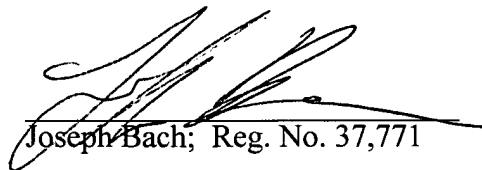
On the other hand, August discloses a “capture device” that captures the rider signal. However, even if one considers the capture device to correspond to the claimed “main processor,” it still fails to disclose or suggest the quoted limitation. That is, August’s capture device fails to disclose or suggest the limitation “directing said programming signal to the audio player,” because in August the programming signal has already been played and perceived by the user. Again, the Examiner failed to provide any indication as to how August combined with Noreen make this limitation obvious.

Thus, as can be seen, the claimed limitation to “main processor” is not disclosed nor suggested by August. If one argues that August’s receiver 10 is the main processor, then August’s “main processor” fails to store the rider signal on a rider buffer, but rather plays the rider signal on the audio player. If one argues that August’s capture device 110 is the main processor, then August’s “main processor” fails to send the programming signal to the audio player. Even if one takes the entire system of August to be the claimed Audio system, still there’s no disclosure or suggestion for an element that corresponds to the claimed “main processor.” That is, there’s no teaching or suggestion for an element that receives the combined signal, sends the program signal to the audio player, and sends the rider signal to a memory.

Conclusion

It is believed that all rejections made by the Examiner have been addressed and overcome by the above arguments. Therefore, it is respectfully submitted that all of the pending claims are allowable. Accordingly, a reversal of all the pending rejections is respectfully requested.

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(9) Appendix of Pending Claims

1. An interactive audio system, comprising:
 - a home audio system having a user interface;
 - a communication device connecting said home audio system to a telephone;
 - an audio player receiving music signal and audibly playing music pieces from said music signal;
 - a rider buffer storing data corresponding to said music pieces;
 - a main processor receiving a programming signal and a rider signal from a program transmission channel and directing said programming signal to the audio player and storing the rider signal in the rider buffer;
 - an ordering interrupter;
 - wherein upon receiving a command from the user interface, said ordering interrupter instructs the communication device to establish communication with an ordering center via said telephone, and places an order for a hard copy of the music piece corresponding to the data stored in said rider buffer.
2. The system of claim 1, further comprising an ordering memory having ordering data stored therein.
5. The system of claim 1, wherein said communication device comprises a cellular phone.
6. The system of claim 1, wherein said communication device comprises a modem.